

It is clear from the above comparison that Applicants original claim 2 is directed to "substantially the same invention" as the issued patent, U.S. 5,679,796. This has been pointed out to the Examiner in several communications.

37 CFR 1.605 (a) states:

If no claim in an application is drawn to the same patentable invention claimed in another application or patent, the examiner may suggest that an applicant present a claim drawn to an invention claimed in another application or patent for the purpose of an interference with another application or a patent.

In the present case, Applicant's submit that 37 C.F.R. 1.605(a) does not apply since there is a claim already present in the application drawn to the same patentable invention. Further, it was not required that the Examiner present a claim in the case where there is a claim present in the application drawn to substantially the same patentable invention. In order for an application claim to be for "substantially the same subject matter" as a patent claim, it must contain all the material limitations of the patent claim. Rieser v. Williams, 255 F.2d 419, 118 USPQ 96 (CCPA 1958). Again, from the above chart, it is clear that all of the material limitations of the patent claim are present in original claim 2. Although Applicants believe that the application as originally filed contains a claim to substantially the same patentable invention, this amendment is being made for purposes of provoking an interference.

The Examiner has stated that Applicants response in three months was neither timely nor appropriate and that failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter.

Applicants attempted to reply in both a timely and appropriate manner with the last response that was filed on February 22, 2001. However, it did not come to Applicants' attention that the response was not timely until preparing to respond to this Office Action which was mailed on May 18, 2001. The Examiner has indicated that by not responding in a timely and appropriate manner, Applicants have disclaimed subject matter. Reconsideration of the position of the Examiner with regard to this disclaimer is requested for the following reasons.

Historically, the following actions have taken place in the prosecution of this application:

1. Application filed 10/26/98 as a 371 of PCT/EP96/05564 (12/12/96) with priority to Swiss application filed 12/21/95.
2. IDS filed 3/31/99
3. Restriction Requirement (**Note: Office Action Summary page indicates shortened 1 month response period**)
4. Applicants responded to restriction requirement (5/18/99)

5. Office Action (6/28/99) – Examiner rejected claims as not being made prior to one year from date on which U.S. 5,679,796 was granted.
6. Applications Request Reconsideration (9/27/99) for the following reasons:
 - a. The PTO has neglected to carry its burden for establishing a *prima facie* case as to why 35 U.S.C. § 135 should operate in the instant case to effect a statutory bar, estoppel or loss of right.
 - b. Applicants' claims in question were made prior to one year from the date on which US Patent 5,679,796 was granted.
7. Final Rejection (11/05/99) – Examiner stated that Applicants are not entitled to an earlier date of PCT and Swiss applications because Applicants failed to comply with 37 C.F.R. 1.495(b).
8. Notice of Appeal (5/5/00)
9. Appeal Brief Filed (8/10/00) The final rejection raised a single issue: Are Claims 1 – 7, 9, 12 and 13 Unpatentable Under 35 USC §135(b) as Not Being Made Prior to One Year From the Date on Which U.S. Patent No. 5,679,796 was Granted?
9. Office Action (mailed 9/22/00) – Withdrawing Finality of Action (**Note: Office Action Summary Sheet set 3 months as statutory period for response**). The Examiner suggested an allowable claim for purposes of copying.
10. Response (2/22/01) – Applicants did not copy claim since a claim for “substantially the same invention” was present in the application as originally filed.
11. Office Action (mailed 5/18/01) – Examiner states that Applicants failure to present claims amounts to concession that patentee is first inventor in this country.

The portions of the above summary that have been highlighted show the inconsistency of preparation of the Office Actions which led to Applicants being placed in the adverse position of “disclaiming” subject matter which Applicants believe they are the first inventors of. In Paper No. 18 (mailed 9/22/00), the “Office Action Summary” states that the period for response is set to expire “3 months” from the mailing date of the communication. Based on this, the docketing clerk set the period to expire on 12/22/00 with normal extension periods available under 37 CFR 1.136(a) until 3/22/01. Applicants responded to the Office Action on February 22, 2001.

However, buried in the Office Action on the last page was a “One Month or Thirty Day” time period without extensions available, therefore the Examiner states that Applicants response was neither timely nor appropriate. Applicants submit that this hidden shortened statutory period for response should not cause Applicants to lose their claimed invention. Applicants have processes in place such that the docketing clerk reads the Office Action Summary page and inputs this date as

the date a response is due. Applicants should not be penalized for a "hidden" shortened statutory response date which was on the last page of the Office Action. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(g) is respectfully requested.

Further, by reviewing the prosecution history of this case it is clear that the Examiner has conceded that Applicants had presented a claim within one year of the grant date of the patent as required under 35 U.S.C. § 135(b). Applicants' Appeal Brief presented persuasive arguments as to why 35 U.S.C. § 135(b) was not applicable since Applicants had presented claims prior to one year from the date on which U.S. '796 had been granted. Based on the Appeal Brief, the Examiner withdrew the finality of the rejection, thereby admitting the present application contains claims to "substantially the same subject matter" as at least one of the claims of the patent; and that the claims were presented within the required one year time period. Both of these conditions were met prior to the expiration of the one-year period after grant of the patent.

Now, Applicants are being held to not have complied with a requirement the Examiner admits they have already complied with. Applicants respectfully request that the Examiner reconsider the Office Action mailed on May 18, 2001; withdraw the rejection under 35 U.S.C. § 102(g) and declare an interference pursuant to 37 CFR 1.607.

In compliance with the requirements of 37 C.F.R. 1.607, the following points are noted:

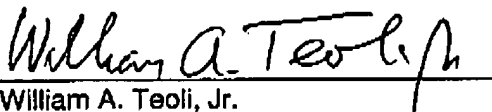
1. The patent with which interference is requested is U.S. Patent No. 5,679,796.
2. The Count that Applicants propose for the interference is newly added Claim 69, added by this Amendment.
3. Claim 1 of Kraatz '796 corresponds to the proposed Count.
4. Claims 2-7, 9, 10, 12-14 and 69 correspond to the proposed Count. These claims, while not identical to the proposed Count, are deemed to define the substantially the same invention as the proposed Count.
5. The requirements of 35 U.S.C. § 135(b) are met in view of the fact that claims 2-7, 9, 10 and 12-14 were presented less than one year from the October 21, 1997 issue date of Kraatz '796. Moreover, claims directed to substantially the same subject matter were presented almost a year prior to the issue date of the Kraatz '796 patent.

Moreover, on the basis of Applicants' entitlement to the benefit of their prior filed international and Swiss applications, Applicants are entitled to status as Senior Party in the interference proceeding and such status is requested.

Applicants respectfully request entry of this amendment and a favorable reconsideration of this application. It is further requested that an interference between this application and Kraatz '796 be instituted as soon as possible.

Respectfully submitted,

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